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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,771	10/23/2003	Joel William Olney	461391/0029	6706

7590 05/11/2004  
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EXAMINER

MAI, HUY KIM

ART UNIT PAPER NUMBER

2873

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/691,771	Applicant(s) OLNEY, JOEL WILLIAM	
	Examiner Huy K. Mai	Art Unit 2873	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply.**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3,7-11,21-28 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,7-11,21-28,32-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/23/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The Information Disclosure Statement filed on Oct. 23, 2003 is acknowledged.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

3. This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. The newly added limitations “thin silicone membrane”, “a fleece covering” and “a screen material” in claims 22, 25, 26 and 28 are not disclosed in the original parent application. A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.
4. According to the newly added limitations as claimed in claims 22, 25, 26 and 28, the present patent application should be a C-I-P application of the 09/929,910 rather than a CON application as stated in the first page of the specification.

### ***Specification***

5. The disclosure is objected to because of the following informalities: It appears that the phrase “This application is a continuation of” (page 1, line 2) should read –This application is a continuation-in-part of--.

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Appropriate correction is required.

***Claim Objections***

6. Claims 1 and 7 are objected to because of the following informalities: The phrase “same frame” (claim 1, line 4) should read --said frame--. The phrase “one of more fasteners” (claim 1, line 8) should read --one or more fasteners--. The word “wach” (claim 7, line 2) is typo. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 22,25,26 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide support for the limitations claimed in claims 22, 25, 26 and 28. (NOTE: Since these original claims 22, 25, 26 and 28 filed together with the present application and treated as a part of the specification. In order to comply with 35 USC 112, first paragraph, the applicant may add the features in claims 22, 25, 26 and 28 into the specification. By doing so, the rejection will be withdrawn.)

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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10. Claims 1-3,7,8,10,11 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The feature "one or more ventilation opening" (claim 1, line 10) is undefined. The phrase "said means" (claim 35, line 1) has no antecedent basis. Does the applicant mean "said means" by "said one or more fasteners"?

The remaining claims are dependent upon the above rejected base claim and thus inherit the deficiency thereof.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-3,7-9,11 are rejected under 35 U.S.C. 102(b) as being anticipated by Baharad et al (5,802,622).

See the office action in the parent application 09/929,910 mailed on Aug. 20, 2002.

13. Claims 21, 32, 33, and 37 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Angermann et al (4,689,838).

The limitations in claims 21, 37 are shown in Angermann et al's Fig. 1-6. Angermann et al disclose eyewear 10 comprising a frame 22 having an inner surface, an outer surface and at least one lens mounted therein; and, a removable sealing member 15 having a front surface formed to closely engage the inner surface of said frame 22, a rear surface, and one or more fasteners for

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removably attaching the removable sealing member to the frame, wherein said sealing member comprises a gasket 16 on at least a portion of said rear surface for engaging a wearer's skin. Regarding claim 32, Angermann et al discloses the removable sealing member 15 includes one or more ventilation openings 18 therein.

14. Claims 21, 32,34,35, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Baharad et al.

The limitations in claims 21, 37 are shown in Baharad et al's Figs. 1-11. Baharad et al disclose eyewear comprising a frame 2 having an inner surface, an outer surface and at least one lens 30 mounted therein; and, a removable sealing member 20 having a front surface formed to closely engage the inner surface of said frame 2, a rear surface, and one or more fasteners 24,25,26,28 for removably attaching the removable sealing member to the frame, wherein said sealing member comprises a gasket 20 on at least a portion of said rear surface for engaging a wearer's skin.

Regarding claim 32, Baharad et al discloses the removable sealing member 20 includes one or more ventilation openings 80,81 therein.

Regarding claim 34, Baharad et al discloses the lens mounting surface defined one aperture 5 for both eyes of a wearer which is covered by a single lens 30.

Regarding claim 35, Baharad et al discloses said means 24,25,26,28 for removably attaching said sealing member 20 to said frame 2 comprises at least one member 26 at both ends of said sealing member and at least one member 2,25,28 proximate the nose bridge portion of said sealing member.

***Claim Rejections - 35 USC § 103***

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15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baharad et al in view of Fernandez (6,233,342)

See the office action in the parent application 09/929,910 mailed on Aug. 20, 2002.

17. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Angermann et al. Angermann et al disclose eyewear 10 comprising a frame 22 shaped to fit a wearer's face, said frame having an inner surface, an outer surface, a pair of orbital openings for surrounding the eyes of a wearer, a nose bridge connecting said pair of orbital openings, a lens mounting surface mounting a lens within each orbital opening, a temple bracket 32, 39 on each side of the frame 22 for attaching a means 14 for supporting the frame on the wearer's head; and a removable sealing member 15 having an orbital opening, a front surface formed to closely engage the inner surface of said frame, a rear surface, attachment means for removably attaching the removable sealing member 15 to the frame 22, and a gasket covering 16 at least a portion of the rear surface of the removable sealing member for engaging a wearer's skin.

However, the removable sealing means 15 has an orbital opening instead of a pair of orbital openings as claimed. It is commonly known in the art that the air space the eyewear and the wearer's eyes can be separated into a pair of opening or jointed together into a common air space for both eyes.

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It would have been obvious to a person having ordinary skill in this art to modify the Angermann et al's eyewear by separating the air space into two orbital opening as commonly knowledge in the art for providing a separate air space for each eye. Such modification would not change the scope of the Angermann et al's invention as the applicant does.

18. Claims 22-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baharad et al or Angermann et al.

Since one material has properties better than another material, it would have been obvious to a worker having general skill in this art to select a known material on the basis of its suitability for intended used as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.



Huy Mai  
Primary Examiner  
Art Unit 2873

HKM/  
May 6, 2004